

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT O. HEUCKEROTH,
STEVEN P. ADAMS, and
JEFFREY I. GORDON

Appeal No. 94-3919
Application 08/091,550¹

ORDER VACATING REJECTION AND
REMANDING APPLICATION TO THE EXAMINER

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and
McKELVEY, Senior Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed July 15, 1993. According to appellants, the application is a continuation of Application 07/745,660, filed August 16, 1991, now abandoned; which is a division of Application 07/208,192, filed June 16, 1988, now abandoned; which is a continuation-in-part of Application 07/151,774, filed February 3, 1988, now abandoned.

ORDER VACATING REJECTION AND
REMANDING APPLICATION TO THE EXAMINER

Claim 15 is the only claim pending in the application and reads as follows:

15. A method of acylating a peptide or protein comprising reacting the CoA ester of an oxy- or thio-substituted fatty acid analog compound having activity as a substrate of myristoylating enzymes selected from the group consisting of C₁₃ or C₁₄ fatty acids or alkyl esters thereof in which a methylene group normally in a carbon position from 4 to 13 is replaced with oxygen or sulfur with said peptide or protein in the presence of a source of N-myristoyl transferase to thereby decrease the hydrophobicity of the resulting acyl peptide or protein compared to the corresponding myristoyl peptide or protein while maintaining about the same chain length.

The examiner has rejected this claim under 35 U.S.C. § 101 alleging that the claim method "lacks utility." (Examiner's Answer, page 3). In relevant part, the examiner has concluded that "myristoylation of proteins does not constitute any useful practical utility other than to advance further study." (Examiner's Answer, page 4).

Parent application 07/745,660 was the subject of Appeal No. 93-1653. Claim 15, as it was pending the parent application, reads as follows:

15. A method of acylating a peptide or protein comprising reacting the CoA ester of an oxy- or thio-substituted fatty acid analog compound having activity as a substrate of myristoylating enzymes selected from the group consisting of C₁₃ or C₁₄ fatty acids or alkyl esters thereof in which a methylene group normally in a carbon position from 4 to 13 is replaced with oxygen or sulfur with said peptide or protein in the presence of a source of N-myristoyl transferase.

When this application was refiled, claim 15 was amended to add the language describing the decreased hydrophobicity of the resulting acyl peptide or protein. On the record

developed in the parent application, the prior merits panel affirmed the rejection under 35 U.S.C. § 101 of claim 15 as it then read.

In considering the issues raised in this appeal, this merits panel discovered U.S. Patent No. 5,571,689 ('689 patent).² The '689 patent lists four co-inventors including the present three co-inventors. Claim 1 of the '689 patent reads as follows:

1. A method of acylating a peptide or protein at an amino terminal glycine residue of said peptide or protein with an analog of myristic acid to form a N-myristoyl analog peptide or protein comprising reacting said peptide or protein with N-myristoyltransferase and an enzyme substrate consisting of the CoA ester of a diheteroatom-substituted fatty acid analog of myristic acid selected from the group consisting of C₁₃ and C₁₄ fatty acids, in which two non-adjacent methylene groups of said analogs which are normally in positions from 3 to 13 are replaced by oxygen or sulfur to reduce the hydrophobicity of said myristic acid analog.

Claim 15 of this application and claim 1 of the '689 patent differ most significantly in that claim 15 of this application requires the use of a monoheteroatom-substituted fatty acid analog of myristic acid while claim 1 of the '689 patent requires the use of a diheteroatom-substituted fatty acid analog of myristic acid.

The issuance of the '689 patent changes the factual background against which the utility of the method of claim 15 on appeal must be determined. Since the record has significantly changed from that considered by the prior merits panel in the previous appeal and the examiner in considering the issue in this application, we VACATE the examiner's

² A copy of the '689 patent is attached to this opinion.

rejection under 35 U.S.C. § 101 and remand the application to the examiner to assess the new record and make a new determination as to whether the claim on appeal possesses utility under 35 U.S.C. § 101.

We take no position on the merits of the utility issue raised, either on the previous record or the newly expanded record. It may be that the method of claim 15 is not directed to a patentable utility. This assessment, based upon the new record, is best made by the examiner in the first instance. If the reassessment results in the examiner determining that the method set forth in claim 15 on appeal lacks utility under 35 U.S.C. § 101, she should issue an appropriate Office action stating such a rejection. As a second separate matter, we note that the administrative file of this application indicates that the examiner only searched the claimed invention in a single class and subclass. In addition, it does not appear that the examiner has performed a search of any of the electronic databases available to the examiners. In this regard, we note that the face of the '689 patent indicates that a more extensive search was performed on very similar subject matter. Upon return of the application, the examiner should ensure that an appropriate search of the subject matter claimed in this application has been performed.

Appeal No. 94-3919
Application 08/391,550

This application, by virtue of its “special” status, requires an immediate action.
MPEP § 708.01(d). It is important that the Board be informed promptly of any action
affecting the appeal in this case.

VACATED & REMANDED

Sherman D. Winters)	
Administrative Patent Judge)	
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William F. Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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Fred E. McKelvey, Senior)	
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Appeal No. 94-3919
Application 08/391,550

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